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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,509	10/29/2001	Scott Hunt	56442 (71710)	5412

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/28/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,509

Applicant(s)

HUNT ET AL

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Muhanna et al (2002/0058860). Muhanna shows a segmented arm support apparatus for attachment to a surgical retractor comprising an articulating arm 100 having a plurality of segments 110, each segment having a convex outer wall 112 in mating relationship to a concave inner surface 113 of an adjacent segment. Each segment is formed of a material with high stiffness coated with a high friction plating material (paragraph 0043). A cable 101 extends through a passage 114 formed in each segment. A device 128 for tightening the cable is provided for causing the mating segments to be brought into tight frictional engagement. A tissue stabilization device (paragraph 0006) is attached to the arm and is lockable upon tightening of the cable. As to claim 16, the method for stabilizing is inherently carried out during the use of the device.

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Claims 1-3, 5, 9-16, 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Gannoe et al (2002/0077532). Gannoe shows a segmented arm support apparatus for attachment to a surgical retractor 22 comprising an articulating arm 204 having a plurality of segments 206, each segment having a convex outer wall 220 in mating relationship to a concave inner surface 218 of an adjacent segment. Each segment is formed of a material with high stiffness coated with a high friction plating material 222 (see also paragraph 0091). A cable 208 extends through a passage formed in each segment. A device 205 for tightening the cable is provided for causing the mating segments to be brought into tight frictional engagement. A tissue stabilization device 202 is removably attached to the arm and is lockable upon tightening of the cable. As to claims 11-13 and 20-22, the stabilization device is removably attached to the arm by a movable socket 248 slidable along a plunger 266 attached to the end of the cable and wherein the socket is biased against the plunger by a spring 270. As to claims 14, 15, 23 and 24, the arm may be attached to the retractor by a mounting block 72 including a lever 106 for positioning a cam 108. As to claim 16, the method for stabilizing is inherently carried out during the use of the device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gannoe et al (2002/0077532) in view of Leyden et al (6,371,345). While Gannoe discusses using a plating material have a different hardness than the material of the segments (paragraph 0091), he does not specify if the plating material is necessarily softer than the material forming the segments. Leyden utilizes a compressible coating on a ball member to increase frictional resistance between the mating surfaces. The coating reduces the force required to that must be applied to arrest relative movement between the mating surfaces (see column 3, lines 18-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a coating on the segments of Gannoe that is softer than the segment material, in view of Leyden, so that less force would be required to arrest relative motion of the segments. As to claims 7, 8, 18 and 19, Leyden discloses the use of an elastomer material for the friction increasing coating. Without a showing of criticality, the use of the other claimed materials as a coating material would have been obvious to one of ordinary skill in the art, dependent on the material of the segments and the desired tightening force.

Response to Arguments

Applicant's arguments filed September 24, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., that the device for tightening is manual) are not recited in rejected claim 16.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the segments of the articulating arm or Gannoe are not the same size and shape. It is noted that the claims only specifies that a plurality of segments are the same size and shape, which is shown by Gannoe, not that *all* the segments are of the same size and shape.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Leyden states at column 3, lines 18-44, that the coating reduces the force required to that must be applied to arrest relative movement between the mating surfaces.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
November 28, 2003